

## R E M A R K S

Claims 1-10 are in the case. Support for the amendment to Claim is found in the Specification at least at Page 1, lines 17-19, and Page 9, lines 21-22.

### **Rejection under §112, second paragraph**

Claims 1-10 stand rejected under §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter the Applicants regard as the invention, due to the absence of a reaction or product produced in Claim 1. There does not appear to be a requirement that process claims recite a product thereof, or a reaction occurring as part of the claimed process. Original Claim 1 can be characterized as a claim having functional features. In M.P.E.P. §2173.05(g), it is stated that

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226 (C.C.P.A. 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

Applicants submit that original Claim 1 fairly conveys to a person of ordinary skill in the art the subject matter the Applicants regard as the invention. However, in order to expedite prosecution of this case, Claim 1 has been amended. As amended, Claim 1 recites a product, an alkylate, and thus this rejection is rendered moot. Applicants request reconsideration and withdrawal of this rejection.

### **Rejection under §102(b)**

Claims 1-8 stand rejected under §102(b) as anticipated by Chou et al. (U.S. 4,918,255). To establish a *prima facie* case of anticipation, not only must the cited reference disclose every element of the rejected claim(s), but the elements disclosed in the cited reference must be arranged as in the rejected claim(s).

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single

reference.” *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990), citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed.Cir. 1988).

In Chou et al., a Group VIII metal is disclosed as part of an alkylation catalyst of a prior patent: where it is stated that

U.S. Pat. No. 3,644,565 discloses alkylation of a paraffin with an olefin in the presence of a catalyst comprising a Group VIII noble metal present on a crystalline aluminosilicate zeolite. The catalyst is pretreated with hydrogen to promote selectivity. (Chou et al., column 2, lines 10-14).

In contrast, the catalyst of Chou et al. includes a Lewis acid, a large pore zeolite and/or a non-zeolitic solid inorganic oxide, all in the presence of a closely controlled amount of water (column 5, lines 40-46). Nowhere in connection with this catalyst does Chou et al. disclose the incorporation or inclusion of any transition metal. The separate disclosure of a Group VIII metal in a discussion of a prior patent does not meet the anticipation standard, and thus Claims 1-8 are novel over the cited reference. Applicants respectfully request reconsideration and withdrawal of this rejection.

#### **Rejection under §103(a)**

Claim 9 stands rejected under §103(a) as obvious over Chou et al. (U.S. 4,918,255), with Biale (U.S. 3,644,565) as incorporated by reference. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Chou et al. and Biale et al. teach away from each other. As noted above, Chou et al. discloses the use of a closely controlled amount of water as part of the catalyst. In contrast, Biale does not teach the inclusion of water in the catalyst. In fact, a careful reading of the entirety of Biale would lead one of ordinary skill in the art to avoid water altogether. Biale teaches the catalyst therein is contacted with hydrogen to impart catalytic activity (column 1, lines 41-55). In describing the preparation of the catalyst, Biale states that the catalyst is subjected to calcining at about 800°-900°F in *dry* air (column 4, lines 35-41, emphasis added). Thus, the disclosures of Biale and Chou et al. teach away from their combination, and Claim 9 is not obvious in light of Chou et al. with Biale incorporated by reference, and Applicants respectfully request reconsideration and withdrawal of this rejection.

**Provisional rejection for non-statutory double-patenting**

Claims 1-10 stand provisionally rejected under the judicially created doctrine of non-statutory obviousness-type double-patenting over Claims 1-42 of Application No. 12/021,096. Enclosed is a Terminal Disclaimer document containing a disclaimer over U.S. Application No. 12/021,096, together with the usual cover sheet. Payment is made herewith from a Deposit Account of the requisite fee for recording the Terminal Disclaimer. Thus the double patenting rejection over Application No. 12/021,096 above no longer applies, and should be withdrawn.

In light of the foregoing remarks, the case is believed to be in condition for allowance. Prompt notification to this effect would be sincerely appreciated.

If any matters remain that require further consideration, the Examiner is requested to telephone the undersigned at the number given below so that such matters may be discussed, and if possible, promptly resolved.

Please continue to address all correspondence in this Application to Albemarle Corporation at their address of record.

Respectfully submitted,

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